



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,549	10/18/2001	Mark Humayun	55299 (71941)	7737

21874 7590 07/17/2003

EDWARDS & ANGELL, LLP  
P.O. BOX 9169  
BOSTON, MA 02209

EXAMINER

SCHOPFER, KENNETH G

ART UNIT	PAPER NUMBER
----------	--------------

3739

DATE MAILED: 07/17/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

EC

**Office Action Summary**

Applicant(s)

09/982,549

Applicant(s)

HUMAYUN, MARK

Examiner

Kenneth G Schopfer

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group II in Paper No. 6 is acknowledged.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 20-22, 25, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones (USPN 6015403).
4. Referring to claims 20-22, 25, and 26, Jones teaches all of the limitations of these claims. The use of the device of Jones teaches a method for performing an ophthalmic surgical procedure including the steps of providing a surgical device with an elongated body and a soft tip at the distal end that is easily visible during a procedure; making an incision in the eye; inserting the surgical device into the treatment area; performing a procedure; and removing the device. The visualization of the soft tip is enhanced by shining a light via a light source including a fiber optic probe onto the tip of the device and the treatment site.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3739

6. Claims 23, 24, and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (USPN 6015403) in view of Waner et al. (USPAP 2002/0115922).

7. Referring to claims 23 and 24, Jones teaches all of the limitations of these claims as described above except for the step of causing the soft tip to glow or fluoresce. Waner et al. teach a medical device that includes an elongated body that is marked by areas of varying optical properties such that a user can easily visualize and monitor the position of the device. It would have been obvious to one of ordinary skill in the art at the time of invention that the tip of the device of Jones could be made with varying optical properties as in Waner et al. including the ability to glow when a light is shone upon it in order to facilitate the visualization of the tip by a user during a procedure (see paragraphs 0011-0013 of Waner et al.).

8. Referring to claim 27 and 30, Jones teaches all of the limitations of these claims as described above except for the coloring of the soft tip. Waner et al. teach a medical device that includes an elongated body that is marked by areas of varying optical properties such that a user can easily visualize and monitor the position of the device. It would have been obvious to one of ordinary skill in the art at the time of invention that the tip of the device of Jones could be made with varying optical properties as in Waner et al. including the coloring of the tip with fluorescent material in order to facilitate the visualization of the tip by a user during a procedure.

9. Referring to claims 28 and 29, Jones teaches all of the limitations of these claims as described above except for the coloring of the soft tip. Waner et al. teach a medical device that includes an elongated body that is marked by areas of varying optical properties such that a user can easily visualize and monitor the position of the device. It would have been obvious to one of ordinary skill in the art at the time of invention that the tip of the device of Jones could be made

Art Unit: 3739

with varying optical properties as in Waner et al. including the marking of the tip with a fiducial ring in order to facilitate the visualization of the tip by a user during a procedure.

10. Claims 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (USPN 6015403) in view of Helfgott et al. (USPN 4530356).

11. Referring to claim 31, Jones teaches all of the limitations of this claim as described above except for the use of the device in a vitrectomy procedure. Jones also teaches that the surgical device may be an aspirating device. Helfgott et al. teach a similar device that may be used to perform a vitrectomy including the steps of cutting the vitreous body from the retina; removing the body; pushing the retina against the wall of the eye; draining subretinal fluid; and allowing fluid from the blood to fill the vitreous cavity. It would have been obvious to one of ordinary skill in the art at the time of invention that the device of Jones et al. could have been effectively used in a vitrectomy procedure as in Helfgott et al.

12. Referring to claims 32-34, the combined device and method of Jones and Helfgott et al. teaches all of the limitations of this claim as described above. It would have been obvious to one of ordinary skill in the art at the time of invention that the aspirating device or soft tip could have been used to push the retina against the wall of the eye and the aspirating device could have been used to drain subretinal fluid in order to perform the vitrectomy effectively.

13. Referring to claim 35, the combined device of Jones and Helfgott et al. teaches all of the limitations of this claim as described above. Also, Helfgott et al. teaches that the tip of the device may include an abrasive surface to remove scar tissue from the eye (column 15, lines 3-20). It would have been obvious to one of ordinary skill in the art at the time of invention that

Art Unit: 3739

the combined device and method of Jones and Helfgott et al. could include a tip with an abrasive surface in order to remove scar tissue from the eye during a procedure.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth G Schopfer whose telephone number is 703-305-2649.

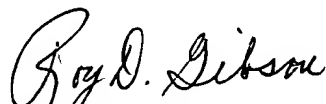
The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 703-308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

KS

KS  
July 11, 2003

  
ROY D. GIBSON  
PRIMARY EXAMINER